

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 29, 2009. At the time of the Final Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 4-6, 12, and 15-17 are herein amended. Claims 2-3, 7-9, 13-14, and 18-20 were previously withdrawn due to an election/restriction requirement. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1, 4-6, 10-12, and 15-17 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner stated that the elected embodiment (as shown in Fig. 6) does not include the limitation of a “second section,..., including multiple courses of,..., threads,... wherein, in the second section, thread flanks, ..., are not in contact with corresponding thread flanks, ..., such that a continuous cavity for receiving thread sealant is formed”. Applicant respectfully disagrees. Fig. 6 shows this section with numeral 8. Similar as in Figs. 1-5, Fig. 6 uses hatching to indicate the cavity. Moreover, numeral 6 indicates this cavity.

Claims 1, 4-6, 10-12, and 15-17 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner stated that the above limitation is indefinite. Applicant respectfully disagrees. According to the independent claims the first section includes a “normal” thread section 7 in which, for example, the left flanks of the inner cylindrical thread 2 of part 1 are in direct contact with the right flanks of the exterior cylindrical thread 4 of part 3. In the second section 8, the interior cylindrical threads 2 and the exterior cylindrical thread 4 are offset such that a cavity 6 is formed into which a sealant is inserted. The terms, “thread”, “thread flank”, “cavity” are well known in the art of mechanical connectors. The Examiner particularly construed this claim language to include a continuous three-dimensional space wherein flanks of one side of each thread in the section are in contact. Even though, Applicant believes that a definition of such a three-dimensional space would be sufficiently clear to a person skilled in the art, no such

definition is present in the independent claims. The independent claims only claim a cavity for the second section 8. In this section, however, the flanks of the interior and exterior cylindrical threads are not in contact. If they are not in contact, then the flanks must define a three-dimensional space. Hence, Applicant believes that the claim language is sufficiently clear.

Rejections under 35 U.S.C. § 102

Claims 1-6 and 12-17 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,079,181 issued to H.T. van der Wissel ("*Wissel*").

Claims 1, 4-6, 10, 12, and 15-17 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by *Wissel* in view of U.S. Patent Application Publication No. 2002/0076273 filed by Kenneth J. Carstensen ("*Carstensen*").

Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

In his rejection, the Examiner confirms that *Wissel* does not disclose a "thread sealant". However, the thread sealant is a limitation cited in all independent claims. Hence, any rejection based on 35 USC §102 is improper because the reference clearly lacks the claimed element as admitted by the Examiner.

Rejections under 35 U.S.C. §103

Claims 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Wissel* in view of *Carstensen* and further in view of U.S. Patent No. 5,249,556 issued to William J. Emmitt ("*Emmitt*"). Applicants respectfully traverse and submit the cited art combinations,

even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicant amended the independent claims to include that the interior and exterior threads are cylindrical. This limitation is clearly disclosed in Fig. 6. Thus, no new matter has been introduced. *Wissel* discloses a different type of thread. According to *Wissel*, a conical thread is used in both parts, i. e. tapering pin member 1 and box member 3. This specific design allows for shoulders 5 and 6 to generate a compressive force and a welding effect between the screw threads will be sufficiently large to transfer the torque to be transmitted by the joint. (*Wissel*, col. 3, lines 16-22) Hence, *Wissel* teaches away from using cylindrical threads as well as from using a sealant because the specific conical design, wherein the taper of the box is slightly less than the taper of the pin (*Wissel*, col. 3, lines 11-15) will produce a welding effect and thus do not require a sealant. Hence, *Wissel* in view of *Emmit* will not render the independent claims obvious. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the

Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe no fees are due; however, should the Commissioner deem that any additional fees are due, including any fees for any additional extensions of time, the Commissioner is hereby authorized to debit said fees from deposit account number 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457-2030.

Respectfully submitted,
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